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OFFICE OF PETITIONS

In re Application of :
Lorincz et al. : DECISION ON
Application No. 09/210,031 : PETITION
Filed: December 11, 1998 :
Atty Docket No. 2629-4005US1 :
:

This is a decision on the "PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT," filed April 5, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred twenty-nine (129) days to two hundred sixty-three (263) days.

The application for patent term adjustment is **DISMISSED**.

However, for the reasons set forth herein, correction of the patent term adjustment at the time of the mailing of the notice of allowance is required. The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is ninety-nine (99) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On February 1, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 129 days. On April 5, 2005, applicants timely submitted the instant application for patent

term adjustment¹. Applicants contend that the period of adjustment for Office delay should be 263 days rather than 129 days. Specifically, applicants argue that in view of the withdrawal of the finality of the Office Action dated October 10, 2003 and under 37 C.F.R. § 1.703(a)(2), the period of adjustment of patent term due to examination delay should be the number of days in the period beginning on the day after the date that is four months after the RCE was filed (i.e. December 27, 2003) and ending on the date of mailing of the non-final rejection (i.e. September 15, 2004).

Applicants' argument is not well taken. Pursuant to 37 C.F.R. § 1.702(a),

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

....

- (2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

On October 10, 2003, the Office mailed a final rejection in response to, and within four months of, applicants' filing of a request for continued examination (RCE) on August 27, 2003. Thus, there was no examination delay within the meaning of § 1.702(a)(2). The October 10, 2003 date was the proper date to use in calculating Office delay. The subsequent mailing of a non-final Office action withdrawing the finality of the final rejection does not negate the fact that the Office responded within four months to the filing of the RCE. Furthermore, it is noted that the finality of the Office action was withdrawn only because the status of claim 50 was improperly listed as allowed on the Office action summary.

However, a review of the application history does reveal a basis for entry of a period of reduction for applicant delay.

¹ PALM records indicate that the Issue Fee payment was received on April 29, 2005.

Specifically, applicants took in excess of three months to file a response to the final rejection mailed April 28, 2003. The responsive RCE was filed on August 27, 2003, three months and 30 days later. Pursuant to § 1.704(b), a period of reduction of 30 days is entered.

The determination of patent term adjustment at the time of the mailing of the Notice of Allowance is ninety-nine (99) days.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin A. Ferriter
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Updated PAIR Screen